

REMARKS

Substantive rejections will be addressed first, with response to other matters provided below. The paragraph numbering of the Office Action is used in the following.

4. CLAIMS 81-88, 132-136 and 142-144.

These claims are rejected under Section 102(b) as being anticipated by US patent 5,799,286 (“Morgan”).

THE MORGAN PATENT

As background, Morgan explains that conventional costing and management decision support systems “use traditional profit and loss statements” for “determining product costs and sales prices and apportioning overhead costs” (col. 1, lines 10-16). Morgan further states that with reduced material and labor consumption, “indirect activities have become a significant factor” whose cost, if not taken into account, may cause “pricing errors”, etc. (col. 1, lines 19-28). Morgan goes on to describe the objective to “associate costs with activities” (col. 1, lines 28-29). That leads to “a need for an automated activity-based management system(ABM)” that eliminates or reduces such pricing errors and other disadvantages of prior systems. (Col. 1, lines 59-65.)

Morgan shows an ABM system in Fig. 1, wherein “activity information and traditional accounting information are fed into a relational database 12.” The information is processed and “costs associated” with various “components (20, 22, 24, 26) of activities are computed.” That enables more accurate reports “for trending, forecasting,

comparison, benchmarking, and budgeting purposes” to be generated as indicated at 50 in Fig. 1. (Abstract.)

Thus, by using both “activity information and traditional accounting information” the Morgan ABM system is able to generate reports based on assembling all relevant costs, so as to avoid “pricing errors” and other disadvantages of prior systems. It should be noted that, with this focus on assembling all relevant costs of a component, Morgan expresses no interest or concern about information relating to deficiencies.

CLAIM INTERPRETATION

As clearly confirmed by the MPEP, in Section 2111.01 under heading III, an applicant “is entitled to be his own lexicographer,” so that

Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim.

(Citing authority.

In the present case, attention is directed to page 13 of the specification, beginning at line 5, where it is stated:

A deficiency in a resource is anything that is less than a best performance for a resource.

This is followed by a discussion of types of deficiencies to line 28 of page 13. Then, beginning at line 20, on page 15, there is discussion of deficiencies relating to interactions between “one resource and another.”

For example, as stated on page 13, lines 7-8, “a deficiency may be relative to a

best-in-class resource or relative to a goal or objective of an enterprise.” Thus, a deficiency may be a representation of an insufficiency, inadequacy or shortfall in operating efficiency or time between failures which results from using a given system, relative to results which could be achieved by use of a best-in-class or optimized system, for example, This representation of the deficiency can be stated in terms of cost differential or cost impact of the loss of operating efficiency or shorter failure time (e.g., the deficiency cost), rather than in terms of the actual cost of the system itself. Consistent with this, at page 25 for example, it is described how an efficiency analyzer:

compares the estimated life of the resource with the goals and objectives of the organization. In particular, for each deficiency of each resource, a **cost impact of the deficiency** may be stored. This cost impact and the estimated life of the resource are compared to the stated goals and objectives. If these are not compatible, e.g., goal of 200 days with no downtime and the estimated life is 100 days, a deficiency is noted. (Page 25, lines 3-9; emphasis added.)

Thus, stating a deficiency in the estimated life of a resource in this example as a cost impact (e.g., caused by shorter life) is a representation of the deficiency itself, not a representation of the total cost of the resource or system itself (total cost being the objective of Morgan).

It is respectfully submitted that in view of use of the term “deficiency” as defined

in the specification, claim 81 cannot reasonably be interpreted as being anticipated by the Morgan disclosure.

OFFICE ACTION RELIANCE ON INTERPRETIVE MEANING

As stated in heading I in MPEP Section 2111.01: “THE WORDS OF A CLAIM MUST BE GIVEN THEIR ‘PLAIN MEANING’ UNLESS THEY ARE DEFINED IN THE SPECIFICATION.” With respect to the plain meaning of a word, the use of dictionary definitions to “determine the ordinary and customary meaning” of words “to those skilled in the art” is provided for under heading II of Section 2111.01.

In the present case, the dictionary provides the plain meaning of “deficiency”:

The quality or condition of being deficient; incompleteness or inadequacy.

The word “deficient” itself, being defined as:

Lacking an essential quality or element (as in, deficient in common sense).

Inadequate in amount or degree; insufficient (as in, a deficient education).

(The American Heritage Dictionary, 3rd Ed., Houghton Mifflin Co., 1992.)

In contrast, the same dictionary provides the plain meaning of “cost”:

An amount paid or required in payment for a purchase; a price.

The expenditure of something, such as time or labor, necessary for the attainment of a goal.

In the Office Action, the cornerstone of the rejection is the statement that “the Examiner interprets ‘cost’ to be a form of ‘deficiency’.” However, as shown by the dictionary definitions, “cost” and “deficiency” are not synonymous and the plain meaning

of “cost” does not encompass deficiencies. As will be discussed further, it is respectfully submitted that the Office Action sets forth no support for the interpretation relied upon.

CLAIM 81

As noted, claim 81 stands rejected under Section 102(b) as being anticipated by Morgan.

The MPEP states, in Section 2131, that:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. (Citing authority.)

The first element of applicant’s claim 81 is:

a deficiency database including information regarding deficiencies of resources;

As shown above with specific reference to the cited patent, Morgan discloses an automated ABM system which uses “activity information and traditional accounting information” to “generate costs associated with activities” in order to generate reports “for trending, forecasting, comparison, benchmarking, and budgeting purposes” (Abstract). Thus, while the first element of claim 1 refers to “a deficiency database” and “information regarding deficiencies”, in contrast Morgan focuses on reports reflecting all relevant costs of activities and components and does not focus on deficiencies. Deficiencies are simply not the subject matter of the reports which are Morgan’s objective.

Recognizing the absence of any expressed disclosure by Morgan regarding deficiencies, the Office Action proceeds with total reliance on the interpretation of “cost” as a form of “deficiency.”

MPEP Section 2111.01, in the second paragraph of part II, addresses at length the requirements for establishing a meaning for a term used in a claim. As stated there, the “ordinary and customary meaning of a term may be evidenced by a variety of sources”, listing many possible sources. What is critical in the MPEP text on this subject is that if a particular interpretation is to be relied upon, that interpretation must be “evidenced” or substantiated by identification of an authority or source which provides evidentiary support for the meaning sought to be relied upon.

In the present instance, it is respectfully submitted that no evidence has been identified to substantiate the interpretation of the word “cost” to be a form of “deficiency.” It is therefore further respectfully submitted that the Office Action fails to substantiate the interpretation of “cost” to be a form of “deficiency” in the context of claim 1.

Considering the third element of claim 81 in the context of the complete claim, it will be seen that a processor is arranged to use “deficiency information” and “resource information”

to provide information regarding a characteristic of a resource based on one or more deficiencies related to at least one resource (lines 6-10).

In view of the discussion presented above, it is respectfully submitted that Morgan

fails to teach either of these elements of claim 81 and thus fails to disclose each element of the claim, as necessary for an anticipation rejection.

As to anticipation, the MPEP further provides, in Section 2131, that:

The identical invention must be shown in as complete detail as is contained in the . . . claim. (Citing authority.)

In the present instance, the stated objective of Morgan is to provide reports for various purposes, taking into account all relevant costs of activities and components. It has not been shown how an ABM system arranged for that purpose can be the “identical invention” as applicant’s claimed combination arranged for the different purpose of providing information “regarding a characteristic of a resource based on one or more deficiencies” as more fully set forth in claim 81. Morgan doesn’t even mention deficiencies.

Reconsideration and allowance of claim 81 are requested.

DEPENDENT CLAIMS 82-88

These claims, which would become allowable with allowance of claim 81, include additional distinguishing limitations.

For example, claim 83 describes a resource management system arranged to provide information based on “deficiencies relating to interactions among resources.” No reference to deficiencies relating to interactions among resources is included at column 2, lines 38-58, of Morgan.

Claim 84 describes inclusion of information regarding deficiencies of particular

resources. The abstract of Morgan describes assembly of all relevant costs of various activities and components, however, there is no suggestion of concern about deficiencies.

Claim 88 describes a resource management system wherein “information on cost impacts of deficiencies” is included in a deficiency database. At column 17, lines 33-41, Morgan addresses impacts of cost reductions and volume changes, however, no aspect of any deficiency is addressed.

CLAIM 132

As more fully set out in the claim, claim 132 includes steps of:

providing a deficiency database . . .

providing a resource database . . .

deriving . . . information regarding a characteristic of a resource based on one or more deficiencies . . .

In contrast, consideration of tables provided by Morgan (Table B, at column 9, and Table J, at column 17, for example) illustrates that Morgan provides for collection of all relevant costs of activities and components. In so doing, Morgan does not disclose for the providing or use of information regarding deficiencies of resources.

In view of the discussion provided above, it is respectfully submitted that Morgan does not disclose “each element” of claim 132 and does not show the “identical invention,” as necessary for anticipation under Section 102(b). Reconsideration and allowance of claim 132 are requested.

DEPENDENT CLAIMS 133-136 AND 142-144

These claims, which would become allowable with allowance of claim 132, include additional distinguishing process limitations.

For example, claim 134 covers “providing a deficiency database including information regarding deficiencies relating to interactions among resources.” Applicant has found no disclosure relevant to interaction based deficiencies at the identified text of Morgan (col. 2, lines 38-58).

Similarly, as to claim 136, column 17, lines 33-41, of Morgan have not been found to provide disclosure on “cost impacts of deficiencies” applicable to anticipation of claim 136.

As to claims 142, 143 and 144, the relied-upon text portions of Morgan have not been found to anticipate access to a deficiency database relative to “a preferred combination of resources”, “deficiencies relating to the combination of resources” or “a modification” for compatibility, as provided for in respective claims 142, 143 and 144.

8. CLAIMS 139-140 AND 145

These claims, which would become allowable with allowance of claim 132, are rejected under Section 103(a) as being unpatentable over Morgan in view of US Patent 5,586,252 (“Barnard”).

This rejection places primary reliance on the disclosure of Morgan, with secondary reliance on Barnard to provide disclosure relating to failure modes. With such reliance on Morgan, a critical aspect of this rejection is thus the previously discussed

statement in the Office Action that: “the Examiner interprets ‘cost’ to be a form of ‘deficiency’.”

With respect to Section 103 rejections, MPEP Section 2142 states:

The examiner bears the initial burden of **factually supporting** any *prima facie* conclusion of obviousness. (Emphasis added.)

The applicant then has the right to consider the factually supporting evidence and to refute any *prima facie* showing which has been put forward. With respect to the meaning of words used in claims, MPEP Section 111.01, part II, provides extensive instruction as to the variety of sources which can be relied upon to provide necessary supporting evidence to substantiate asserted meanings of words. However, in the present case the Office Action provides **no evidence** to support the interpretation critical to the rejection.

As a result, it is respectfully submitted that the initial burden has not been met and no *prima facie* showing has been established. In the absence of a *prima facie* showing the burden of proof does not shift and “the applicant is under no obligation to submit evidence of nonobviousness.” (MPEP Section 2142).

Reconsideration and allowance of claims 139-140 and 145 are requested.

(It should be noted that, while this rejection specifically states reliance on motivations “to examine causes of a defect” and “to know how to prevent these causes [of failure] from occurring”, there is no suggestion of how these motivations are relevant to the actual subject matter of applicant’s claims. Motivations of only a general nature are inadequate to support a *prima facie* showing. Further, there is no showing of how any

teaching of Barnard could actually be combined with the financial reports of Morgan, which are not concerned with failure prevention.)

9. CLAIM 141

Claim 141, which would become allowable with allowance of claim 132, is rejected under Section 103(a) as being unpatentable over Morgan in view of Publication US 2001/0027455 A1 (“Abulleil”).

This rejection places primary reliance on the disclosure of Morgan, with secondary reliance on Abulleil to provide disclosure relating to life cycle costs. With such reliance on Morgan, a critical aspect of this rejection is thus the availability of evidentiary support for the Office Action position that the word “cost” can be interpreted to be a form of “deficiency.” As discussed above, in the absence of evidence supporting the word meaning relied upon in a rejection, no sufficient *prima facie* showing is established. As a result, no burden of proof shifts to the applicant.

Reconsideration and allowance of claim 141 is requested.

(It should be noted that while paragraph 59 of Abulleil refers to life cycle costs, it fails to provide any disclosure of deriving a life cycle cost estimate in response to “a deficiency related to a resource.” Thus, Abulleil discusses **use** of life cycle costs, but discloses nothing about **deriving** such costs in a manner anticipating the subject matter of claim 141.)

10. CLAIMS 137-138

These claims, which would become allowable with allowance of claim 132, are

rejected under Section 103(a) as being unpatentable over Morgan in view of US Patent 5,210,704 (“Husseiny”).

This rejection places primary reliance on the disclosure of Morgan, with secondary reliance on Husseiny to provide disclosure relating to information regarding “estimated life of a resource.” With such reliance on Morgan, a critical aspect of this rejection is thus the availability of evidentiary support for the Office Action position that the word “cost” can be interpreted to be a form of “deficiency.” As discussed above, in the absence of evidence supporting the word meaning relied upon in a rejection, no sufficient *prima facie* showing is established. As a result, no burden of proof shifts to the applicant.

Reconsideration and allowance of claims 137-138 are requested.

(It should be noted that the cited portion of Husseiny (col. 2, lines 21-39) is merely “BACKGROUND” review and discusses only general aspects and shortcomings of prior systems and provides no disclosure on deriving or using any estimate of the life of a resource. Husseiny thus provides no disclosure anticipating the subject matter of claim 137 or 138.)

OTHER MATTERS

2. DRAWINGS

The drawings were objected to because of the inclusion of reference characters not mentioned in the description (i.e., Figs. 7C-7F, 12H-12L and 16F).

This application was filed with informal drawings. Upon preparation of the

formal drawings as subsequently filed, it was concluded that while the drawing content was not being changed, nevertheless for clarity of presentation (e.g., adequate size of characters) the content of informal Figs. 7A-7B could better be provided as Figs. 7A-7F of the formal drawings. Similarly, without change of drawing content, informal Figs. 12A-G were replaced by formal Figs. 12A-L and informal Figs. 16A-E were replaced by Figs. 16A-F.

When the formal drawings were filed, the corresponding changes in drawing identification in the description were not made. Replacement paragraphs for the specification, with corrections for this purpose, are provided with this response, including at page 32 correction of the erroneous reference to "Figs. 31A-31E" to correctly refer to Figs. 16A-16F.

Entry of these replacement paragraphs is requested.

3. ABSTRACT

The Abstract was objected to because its length exceeded 150 words. A replacement abstract, revised to provide an accurate summary in shortened form, is included with this response.

Entry, of the replacement Abstract is requested.

4. CLAIM 144

Claim 144 was objected to as informal because, at line 4, an "a" should be inserted between "to" and "characteristic." This response includes an amendment to claim 144 as suggested by the Examiner.

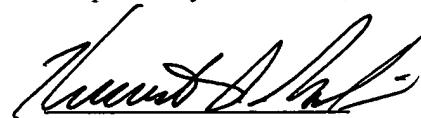
Entry of the claims as now presented is requested.

SUMMARY

Entry of this amendment, reconsideration of all rejections and objections, and allowance of claims 81-88 and 132-145, as amended, are requested.

This application is now considered to be in condition for allowance, which action is respectfully solicited.

Respectfully submitted,



Kenneth P. Robinson
Attorney for Applicant

May 15, 2006

Reg. No.: 20,056
Tel. No.: (631) 385-3255

P.O. Box 328
Greenlawn, NY 11740-0328